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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/748,955	Applicant(s) BOWEN ET AL.	
	Examiner BRENDAN Y. HIGA	Art Unit 2453	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-13 and 15-20 is/are rejected.
- 7) ☒ Claim(s) 2 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/29/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to applicant's amendment and request for reconsideration filed on November 04, 2008.

Claims 1-20 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 7-9, 13, 15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar (US 2004/0004968) ("Nassar") in view of Watanabe et al. (US 2003/0148777) ("Watanabe").

As per claim 1 Nassar teaches a method comprising:

In response to an user's request for at least one service relating to a service provider's network, providing an agent for installation on the user's premises and for coupling to the service provider's network via a physical connection (see Fig. 1, "Router" 115, acting as a DHCP relay "agent", see ¶0029, also the examiner notes that router 115 is inherently installed on the user's premises (see ¶0009, wherein the router is located at the border between the local network of the subscriber [*read as the user's*

premises] and an access network of the home service provider) in response to a user's desire for accessing a home service provider's access network, Fig. 1, ref. 170);

Automatically detecting at the agent an installation of a communications device (see Remote Machine Fig. 1, ref. 110 and 111 and ¶0027) to a local network coupled to the agent (see Fig. 1 and ¶0033, wherein the remote machines 110 and 111 are in communication with the router 115 via the local network of the subscriber, thus inherently the router 115 (read as an agent) has automated instructions for detecting the presence of the remote machines 110 and 111 in order to communicate with them);

Automatically offering via the communications device a plurality of user selectable service options relating to the service provider's network (see ¶0007 and ¶0037-¶0038).

In response to a selection of at least one service option from the plurality of service options, providing via the agent a user connection address ('IP address' see ¶0042-¶0044).

Nassar does not expressly teach the agent detecting at least one capability of the communications device and wherein the user selectable service options are related to the at least one capability of the communications device.

Nevertheless, in the same art of network device configuring, Watanabe teaches an "application awareness application" 134 that is used to detect a type of application (*read as a capability*) that is being used by a communication device. The application awareness application 134 is thus used to help choose an access network 136 (*read as*

a service option) that is suitable for the application being used by the communication device 14 (see ¶¶0049-¶¶0051).

One of skill in the art would have been motivated to modify the teachings of Nassar with the teachings of Watanabe, for including an application awareness application for detecting a type of application running on a communications device and providing a service option related to the type of application. The motivation for doing so would have been to provide a user with service options that match a quality of service requirement associated with applications running on remote machines 110 and 111 of Nassar's invention.

As per claim 3, Nassar further teaches coupling the agent to the service provider's network (see Fig. 1, wherein the router, read as an agent, is coupled to the Home Service Provider Network 170)

As per claim 7-9, Nassar further teaches wherein the physical connection comprises a cable modem, DSL model, and a telephone modem (see ¶¶0008, "cable, DSL, and telephone lines").

As per claims 13 and 15, Nassar further teaches the communications device is a computer and a multimedia device (see ¶¶0027).

As per claim 17, Nassar further teaches wherein the user connection address is an e-mail address (see ¶0048).

As per claim 18, Nassar further teaches wherein the user connection address is an IP address ('IP address' see ¶0042-¶0044).

Claims 19-20 are rejected under the same rationale as claims 1, 3, 7-9, 13, 15 and 17-18 since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar (US 2004/0004968) ("Nassar") in view of Watanabe et al. (US 2003/0148777) ("Watanabe"), in further view of Chiloyan et al. (US 2002/0095501) ("Chiloyan").

As per claim 4, the combination of Nassar and Watanabe teaches before registration of the communications device with the service provider's network, detecting the at least one capability of the communications device (see Watanabe, ¶0049-¶0051 wherein the application awareness program detects the at least one capability before choosing the access network, read as before registration of the communications device with the service provider's network),

The same motivation that was utilized for combining Nassar and Watanabe in claim 1 applies equally well to claim 4.

The combination of Nassar and Watanabe does not expressly teach however, the plurality of user-selectable service options comprising downloading an updated user manual.

However, in the same art of network management, Chiloyan teaches a system for downloading documentation concerning a network device via a web page that includes information pertinent to the peripheral device, including, *inter alia*, access help information (see abstract, read as a user manual).

One of ordinary skill in the art would have been motivated to modify the teachings of Nassar with the teachings of Chiloyan for downloading a user manual in [concerning applications detected by the application awareness program by Watanabe's invention], the motivation for doing so would have been to provide client's with up to date access help information concerning the applications detected by the application awareness program over the Internet (see Chiloyan ¶0008).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar (US 2004/0004968) ("Nassar") in view of Watanabe et al. (US 2003/0148777) ("Watanabe"), in further view of Burst, Jr. (US 7,088,677) ("Burst, Jr.").

As per claim 5, Nassar further teaches registering the communication device with the service provider's network (see abstract), the communications device being a

telephone coupled to the service provider's network via a cable modem (see wireless phone or any other computing device capable of connecting to the packet network, ¶0027)

Furthermore, Nassar teaches the plurality of user-selectable service options comprising general network service provider services for the wireless phone (see ¶0037-¶0038), but not necessarily competitive a competitive local exchange carrier telephone service.

Nevertheless, conventional telecommunications providers offer a broad variety of services, including both voice (i.e. telephone services and data) see for example Burst, Jr. (US 7,088,677) col. 1, lines 23-40, wherein Burst, Jr. also teaches these conventional telecommunications providers including competitive local exchange carriers offering such telephone services (see col. 7, lines 51 - col. 8, line 3).

One of ordinary skill in the art would have been motivated to modify the teachings of Nassar with the teachings of Burst for offering a client with competitive local exchange carrier telephone services, the motivation for doing so would have been to increase the available services offered to a client through Nassar's invention, while also increasing revenue of competitive local exchange carriers offering such telephone services through Nassar's invention.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar (US 2004/0004968) ("Nassar") in view of Watanabe et al. (US 2003/0148777) ("Watanabe"), in further view of Ristau et al. (US 6,374,307) ("Ristau").

As per claim 6, Nassar does not expressly teach accounting for a service provided to the communications device via the service provider's network.

Nevertheless, in the same art of computer network configuring, Ristau teaches a system for accounting for a customer's usage of ISP services (see col. 5, lines 1-22).

One of ordinary skill in the art would have been motivated to modify the teachings of Nassar with the teachings of Ristau for accounting for a service provided to the communications device via the service provider's network. The motivation for doing so would have been to provide a source of revenue for the home service provider in Nassar's invention.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar (US 2004/0004968) ("Nassar") in view of Watanabe et al. (US 2003/0148777) ("Watanabe"), in further view of Kimball (US 6,374,307).

As per claim 10 Nassar does not expressly teach the physical connection comprising a wireless modem.

Nevertheless accessing a server provider's network via a wireless modem's was well known in the art at the time of the invention. See for example, Kimball (US 6,028,984) which discloses the use of a wireless modem for accessing a subscriber's network (see abstract and Fig. 1).

One of skill in the art would have been motivated to modify the teachings of Nassar for using a wireless modem. The motivation for doing so would have been to take advantage of the benefit of having a wireless connection such as increased mobility.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar (US 2004/0004968) (“Nassar”) in view of Watanabe et al. (US 2003/0148777) (“Watanabe”), in further view of Nonomura (US 6,028,984).

As per claim 11 Nassar does not expressly teach the physical connection comprising an optical fiber.

Nevertheless accessing a server provider’s network via an optical fiber was well known in the art at the time of the invention. See for example, Nonomura (US 6,028,984) which discloses an optical fiber connection (see Fig. 1 and col. 5, lines 63-67).

One of skill in the art would have been motivated to modify the teachings of Nassar for using a optical fiber connection. The motivation for doing so would have been to provide a high speed connection to the subscriber’s network.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar (US 2004/0004968) (“Nassar”) in view of Watanabe et al. (US 2003/0148777) (“Watanabe”), in further view of Clark (US 2002/0131123).

As per claim 12 Nassar does not expressly teach the physical connection comprising a free-space optics connection.

Nevertheless accessing a server provider's network via a free-space optics connection was well known in the art at the time of the invention. See for example, Clark (US 2002/0131123) which discloses a free-space optics connections (see abstract and Fig. 1).

One of skill in the art would have been motivated to modify the teachings of Nassar for using a free-space optics connection. The motivation for doing so would have been to provide a connection to a subscriber's network that avoids the need to install costly fiber optics lines, coaxial cables and phone lines (see Clark, 0027).

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar (US 2004/0004968) ("Nassar") in view of Watanabe et al. (US 2003/0148777) ("Watanabe"), in further view of Andersson (US 6,938,079) ("Andersson").

As per claim 16, Nassar does not expressly teach wherein the user connection address is a telephone number.

However, in the same art of network configuring, Anderson teaches a system for providing a client device with one or more telephone numbers for establishing a connection to one of a plurality of computers owned or managed by an ISP (see Fig. 14, col. 42, line 56-col. 43, line 10).

One of ordinary skill in the art would have been motivated to modify the teachings of Nassar with the teachings of Andersson. The motivation for doing so would have been to access the subscriber's network via a dial-up connection.

Response to Arguments

Applicant's arguments filed November 04, 2008 have been fully considered but they are not persuasive.

It is a well settled principle that the patent examiner must give the appellant's claim the broadest reasonable interpretation.

While it is appropriate to use the specification to determine what applicant intends a term to mean, a positive limitation from the specification cannot be read into a claim that does not itself impose that limitation. A broad interpretation of a claim by USPTO personnel will reduce the possibility that the claim, when issued, will be interpreted more broadly than is justified or intended. An applicant can always amend a claim during prosecution to better reflect the intended scope of the claim" *MPEP 2106, sec. (C) Review the Claims*.

Consistent with the MPEP the examiner has given the term *installation* and *automatically* its broadest reasonable interpretation consistent with applicant's specification. For instance, the applicant defines 'installation' as "a state of being installed" and 'automatically' as "acting or operating in a manner *essentially* independent of external influence or control" (here the examiner is interpreting the phrase "essentially" independent of external influence or control as being without manual intervention, see page 4 of applicant specification, "*For example, an automatic light switch can turn on upon "seeing" a person in its view, without the person manually operating the light switch."*")

Thus with respect to applicant's arguments against the examiner's assertion of inherency regarding the installation of the router 115 on the user's premises (see

¶0009, wherein the router is located at the border between the local network of the subscriber [*read as the user's premises*] and an access network of the home service provider), the examiner respectfully disagrees.

The examiner is relying the on the common definition of the word 'install' as "to fit or connect something: to put machinery or equipment in place and make it ready for use" (see MSN Encarta dictionary)). Here, Router 115 is clearly "fit or connected" to remote machines 110 or 111, evidenced by Fig. 1. Furthermore, router 115 is clearly in place and "made ready for use", evidenced by the fact that router performs certain functions of the invention see ¶0029:

Router 115 acting as a DHCP relay agent, forwards the DHCP request from remote machine 110 to DHCP server 160 of the home service provider. As is understood in the art, IP routers are devices that forward IP packets (also known as IP datagrams) based on information in the IP header of an IP packet. In addition, IP routers enable constituent networks to be connected together to form a larger global Internet. Routers typically have at least one physical interface that enables connection to two or more logical interfaces, represented by IP subnets or unnumbered point to point lines. Forwarding an IP packet generally requires the router to choose the address and relevant interface of the next-hop router or the destination host. This choice, called relaying or forwarding, depends upon a routing table (typically stored in a database) within the router. The routing table is maintained dynamically to reflect the current topology of the Internet system.

Furthermore, with respect to applicant's arguments attacking the examiner's assertion of inherency (i.e. "inherently the router 115 (read as an agent) has automated instructions for detecting the presence of the remote machines 110 and 111 in order to communicate with *them*"), the examiner respectfully disagrees.

Router 115 is clearly a machine that performs software or hardware instructions automatically (i.e. independent of a person manually performing each instruction at the

router), thus the detecting of remote machines 110 or 111, for establishing a communication with router 115, are inherently performed via automated instructions according to a protocol, such as TCP/IP.

Finally, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Here, the motivation for combining the teachings of Nassar and Watanabe, is found in the prior art reference itself, see Watanabe ¶¶0049-¶¶0052, which describes the benefit of the application awareness application 134, in that it provides a system with the ability to recommend an access network for a detected application based on certain quality of service measurement, thus improving upon Nassar's invention which provides a user with access to different access networks (Fig. 1, ref. 160 and 190) without taking into consideration a quality of service measurement required for an application running on remote machines (Fig. 1, ref. 110 and 111).

Allowable Subject Matter

Claims 2 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The user-selectable service options as taught by the prior art (see Nassar US 2004/0004968, ¶0037-0038) does not anticipate nor render obvious the communication device being a telephone lacking a display, wherein the user-selectable service options relates to non-visual user interface services, the non-visual user interface services comprising spoken command services for caller ID or push button services for caller ID.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRENDAN Y. HIGA whose telephone number is (571)272-5823. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brendan Y Higa/
Examiner, Art Unit 2453

/ARIO ETIENNE/
Supervisory Patent Examiner, Art Unit 2457